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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/088,707	06/02/1998	CHRIS BERTELO	ATOCM67D1	2062

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EXAMINER

MULLIS, JEFFREY C

ART UNIT	PAPER NUMBER
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1711

25

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/088,707	Applicant(s) BERTELO ET AL.	
Examiner Jeffrey C. Mullis	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2002.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34, 36-39, 41-69, 71 and 72 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-34 and 36-48 is/are allowed.
- 6) ☒ Claim(s) 49-69, 71 and 72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some * c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 - * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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It is noted that line 2 of claim 28 of applicants' clean copy of the claims contains the word "from" which is crossed out. Applicants are reminded that the clean copy should not contain crossed out words.

All remaining rejections and/or objections follow.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 49-68, 70 and 71 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu et al. (USP 5,346,954) or Dunkle (USP 4,659,767), optionally in view of Aoyama et al.

See the Office action in Paper No. 12 page 4 lines 3 et seq.

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Claims 69 and 72 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wang (USP 5,045,595).

Wang discloses a composition produced by forming a polyorganosiloxane latex core and a polyacrylate shell in the presence of a diallyl maleate and butyl acrylate polymer and then forming a further shell of styrene/acrylonitrile. Note Example 15. While it is not clear how much shell is grafted onto the core, applicants' level of shell is within the metes and bounds of that of patent claim 44 and patentee's and applicants' amount of shell or covering in at least one shell or covering of Wang would therefore reasonably appear to be inherently the same as that of applicants especially if the substrate and first shell was viewed as applicants' "core".

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Arguably it may be incorrect that patentee's level of covering core shell is inherently the same as that of applicants in the specific embodiment which utilizes diallyl maleate, namely

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Example 15. However it would have been obvious to a practitioner having ordinary skill in the art at the time of the invention to form amounts of shell or covering as in instant claims 69 and 72 since the patent broadly discloses that such levels may be generated and in the expectation of adequate results absent any showing of surprising or unexpected results.

Applicants' arguments filed 1-7-03 have been fully considered but they are not deemed to be persuasive.

With regard to Brown, applicants argue that the preferred polymers of Brown are composed of butyl acrylate at column 7 lines 26-27. While this may be so, Brown clearly discloses (as applicants point out) the use of C₁-C₅ acrylates and methacrylates in the cores of the core shell impact modifiers of patentees. Therefore there is motivation to use such acrylates. The same can be said for Wu et al. and Dunkle et al. Applicants argue that the references lead one skilled in the art to select at least a portion of alkyl acrylates with smaller alkyl groups such as butyl acrylate particularly since butyl acrylate is said to be preferred. While this may be so, there is nothing in the claims excluding a portion of butyl acrylate in applicants' materials. There is certainly nothing in the instant claims requiring the use of 100 weight percent of C₅ acrylate.

This Office action is not being made FINAL.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (703) 308-2820. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (703) 308-2462. The fax phone number for this Group is before final (703) 872-9310 and after final (703) 8729311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

J. Mullis:cdc

April 5, 2003

Jeffrey Mullis
Primary Examiner
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